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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,706	03/09/2004	Johanna Fraki	442-010769-US (D01)	2938
2512	7590	08/01/2006	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			ARAQUE JR, GERARDO	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,706

Applicant(s)

FRAKI ET AL.

Examiner

Gerardo Araque Jr.

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-54 is/are rejected.
- 7) ☒ Claim(s) 32, 41, and 50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3-9-2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 32 – 35, 37 – 40, 42 – 44, 46 – 50, and 53 – 54**, are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1 – 4, 7 – 8, 30, and 32** of copending

Application No. 10/033151. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10/796706 is just a broader interpretation of Application No. 10/033151 since mobile terminals encompasses cellular phones.

In regard to **claims 32, 43, 50, 53 – 54**, the applicant discloses a method and apparatus using the combination of **claims 1, 2, 4, 30, and 32** for identifying

Art Unit: 3629

a cellular mobile phone within a network and trading a digital collectable card with a second user. The examiner would also like to note that a mobile terminal with a short-range wireless communication transceiver reads upon a cellular mobile phone in that a cellular mobile phone is a short-range transceiver that is dependent by the tower that the phone resides in.

In regard to **claims 35 and 44**, the applicant discloses in **claim 4** that the two mobile terminals are capable of trading the cards. The examiner does not see exactly how it is determined that the second terminal has trading capabilities. As it currently stands **claim 4** already discloses that in order for the two terminals to trade with each other both terminals must be capable of trading cards.

In regard to **claims 37, 39 – 40, 46 – 47 and 52**, the applicant discloses in **claim 8** keeping location information and determining the vicinity of a second cellular phone. Furthermore, as previously discussed the range of a cellular mobile phone is a short-range transceiver that is dependent by the tower that the phone resides in.

In regard to **claims 38 and 48**, the applicant discloses in **claim 3** that the trading is done under the control of a server.

In regard to **claims 42 and 49**, the applicant discloses in **claim 7** of notifying a user for purchase or trade.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Furthermore, the applicant is invited to submit a terminal disclaimer as well.

Claim Objections

3. **Claim 41** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. **Claim 41** reiterates, "...means for detecting whether a second mobile terminal is available for trading..." which is found in **claim 32**. According to Thesaurus.com determining is the same as detecting (<http://thesaurus.reference.com/search?q=determine>).

4. **Claim 32** is objected to because of the following informalities: **line 2 of claim 32** misspells the term "**collectable**" as "**collectible**." Appropriate correction is required.

5. **Claim 50** is objected to because of the following informalities: **line 5 of claim 50** the term "a second mobile" should be read as "a second mobile terminal." Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claim 52** recites the limitation "**the cellular mobile phone**" in **line 8 of claim 53**. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3629

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 32 and 35 – 36, 38, 41 – 45, 48 – 49, 50, and 53 – 54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sehr (US Patent 6,325,295 B1) in view of CNN.com, hereinafter referred to as Lovegety (<http://www6.cnn.com/WORLD/asiapcf/9806/07/fringe/japan.lovegety/>).

10. In regard to **claims 32, 43, and 50**, as best understood by the examiner, Sehr discloses a mobile terminal for trading a digital collectible card associated with a user within a plurality of wireless mobile terminals, also used for trading digital collectible cards associate with other users, via a wireless communication transceiver (Column 3 Lines 12 – 22). However, Sehr fails to teach a means for detecting whether a second mobile terminal device is available.

CNN.com discloses of a device, called the Lovegety, in which a first user would input information regarding their interests and dislikes. The device would then detect whether another Lovegety user (second user) is in the vicinity that shares the same interests of the first user. The device would then beep when they detect another Lovegety within a 15-foot range.

Therefore, it would have been obvious to one having ordinary skill in the art to modify Sehr with the teachings of Lovegety in order to have a user of the mobile terminal to have a means of detecting other users with the same mobile terminal and having similar interests, such as digital collectible cards.

Art Unit: 3629

11. In regard to **claims 35 and 44**, the combination of Sehr and Lovegety, as disclosed above, would inherently comprise a means of detecting whether the second mobile terminal has a digital collectable card trading capability.

12. In regard to **claims 36 and 45**, in further view of the combination of Sehr and Lovegety, as discussed above, Sehr discloses that the mobile terminals have selection features that would allow the user to look for particular items that they would be interested in, such as updating information of a particular card (Column 12 Lines 41 – 56).

13. In regard to **claims 38 and 48**, Sehr discloses that the cardholder must log-on to the appropriate database to request the rendering of a particular service, which would inherently require them to register to the system (Column 16 Lines 44 – 46) and confirming the identities of the cardholders (Column 18 Lines 11 – 13).

14. In regards to **claim 41**, Sehr discloses a mobile terminal for trading a digital collectible card associated with a user within a plurality of wireless mobile terminals, also used for trading digital collectible cards associated with other users, via a wireless communication transceiver (Column 3 Lines 12 – 22). However, Sehr fails to teach a means for detecting whether a second mobile terminal device is available.

CNN.com discloses of a device, called the Lovegety, in which a first user would input information regarding their interests and dislikes. The device would then detect whether another Lovegety user (second user) is in the vicinity that

Art Unit: 3629

shares the same interests of the first user. The device would then beep when they detect other Lovegetys within a 15-foot range.

Therefore, it would have been obvious to one having ordinary skill in the art to modify Sehr with the teachings of Lovegety in order to have a user of the mobile terminal to have a means of detecting other users with the same mobile terminal and having similar interests, such as digital collectible cards.

15. In regard to **claims 42 and 49**, in further view of the combination of Sehr and Lovegety, as discussed above, Lovegety, inherently includes, a means to exchange messages proposing a meeting.

16. **Claims 33 – 34, 37, 39 – 40, 46 – 47, and 51 – 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sehr (US Patent 6,325,295 B1) in view of CNN.com, hereinafter referred to as Lovegety, (<http://www6.cnn.com/WORLD/asiapcf/9806/07/fringe/japan.lovegety/>) and in further view of Newton (Newton's Telecom Dictionary 20th Updated and Expanded Edition).

17. In regard to **claims 33 – 34**, Sehr and CNN.com are discussed above, but fail to explicitly disclose using Bluetooth technology. Newton discloses that Bluetooth is, "A wireless protocol that is used to communicate from one device to another in a small area usually less than 30 feet." Moreover, it is inherent that if a Bluetooth transceiver were to be used then it would be operable to communicate within an operational low power radio range.

Therefore, it would have been obvious to one having ordinary skill in the art to modify Sehr and Lovegety, in combination, to use a Bluetooth transceiver

Art Unit: 3629

as a short-range wireless communication transceiver operable to communicate within an operational low power radio range.

18. In regard to **claims 37 and 46**, Newton discloses that a means of determining whether the first and second mobile terminals are in the same cell of a mobile communication network is old and well known (see Newton: Cell and CMTS).

19. In regard to **claims 39 – 40 and 47**, as best understood by the examiner, Lovegety discloses a means of determining whether another Lovegety user is within the vicinity. Inherently included, Lovegety uses short-range wireless communication.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following are references regarding digital trading between 2 or more devices.

- a. US Patents – 6,325,292 B1; 6,848,997 B1; 6,200,216 B1;
6,656,039 B2; 6,468,162 B1; 6,527,641 B1; 5,411,259; 5,69,561
- b. PGPubs – 2001/0018358 A1; 2001/0039206

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

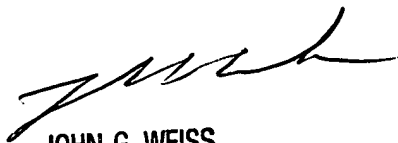
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax

Art Unit: 3629

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GA
7/13/06



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